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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,970	04/20/2001	George Daryl Blankenship	LINCP105US	1244
7590 Himanshu S. Amin Amin & Turocy, LLP 24th Floor, National City Center 1900 E. 9th Street Cleveland, OH 44114		01/23/2008	EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/838,970

Applicant(s)

BLANKENSHIP ET AL.

Examiner

Naeem Haq

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

Claim Objections

Claims 55-57 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are directed to computer-readable mediums having computer-executable instructions for performing the steps of claims 45, 48, and 50 respectively. These claims are improper because they fail the "infringement test" (see MPEP 608.01(n), Section III). Applying the Infringement test, what is needed to infringe claims 55-57 is, for example a CD-ROM having computer executable code that if and when executed would cause a computer to do the steps recited in claims 45, 48, and 50. However, such a CD-ROM would not infringe the method steps of claims 45, 48, and 50 since the CD-ROM itself

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never performs any of the active steps required by the method of claims 45, 48, and 50. In other words, mere possession of such a CD-ROM would infringe claims 55-57, but would not infringe claims 45, 48, and 50. As such claims 55-57 are improper dependent claims.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 38: This claim is directed to a "system" for managing welding consumables. The system has three parts: (1) a consumable monitor "component", (2) a customer "component", and (3) a supplier "component." The Applicants' specification defines a "component" as follows:

"A 'component' is a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution. For example, a component may be, but is not limited being, a process running on a processor, a processor, an object, an executable, a thread of execution, a program and a computer. By way of illustration, both an application running on a server and the server can be components." (see page 5, lines 15-20).

Thus the Applicants' specification teaches that a "component" can be construed as a program (i.e. software). Therefore, the "system" of claim 38 comprises three programs. The Examiner notes that a program or software is nothing more than a series of instructions to perform an action (i.e. an algorithm) (see Microsoft Press Dictionary). Hence, the Applicants' "system" can be construed as comprising three algorithms. None of these "components" recite anything physical to constitute a "system" (i.e. an apparatus) (see MPEP 2106.01(I)).

Referring to claims 37, 43, and 44: Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

Referring to claims 39-42: Claims 39-42 are dependent on claim 38. However, these claims fails to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-48 and 50-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

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was filed, had possession of the claimed invention.

Claims 1, 37, 38, 43, 45, 48, 50, and 54 recite the limitation "...information that includes an indication of ownership of a welding consumable(s)..." This limitation does not have proper written description support in the specification. The Applicant's specification discloses that a supplier can maintain an inventory of welding consumables at a customer location (i.e. vendor managed inventory) (see specification page 10, lines 4-6; page 20, lines 19-21). However, the specification fails to disclose a welder that transmits information including "...an indication of ownership of a welding consumable(s)..."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 38: Claim 38 is directed to a "system". However, as noted above in the 101 analysis, Applicants' invention can be construed as comprising three algorithms. It is unclear to the Examiner how three algorithms can constitute a "system" (i.e. apparatus) since an algorithm has no physical structure.

Referring to claims 37, 43, and 44: Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

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Referring to claims 39-42: Claims 39-42 are dependent on claim 38. However, these claims fail to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niedereder et al. (US 6,797,921 B1) in view of Mottishaw et al. (US 6,721,284 B1) (“Mottishaw”).

Niedereder teaches a method for managing welding consumable(s), comprising:

- receiving information from a monitor that evaluates consumable(s) related to a welder via a computer network regarding consumable usage (*col. 5, lines 25-46; col. 11, lines 28-52*);
- receiving information regarding weld quality (*col. 5, lines 32-36*).

Niedereder does not teach invoicing a customer for the consumable based at least in part upon the information received regarding the consumable usage and the weld quality. However, Mottishaw discloses a method of generating records that bills (i.e. invoicing) based on the quality of service delivered and usage of the service (*col. 8, lines 37-44; claim 10*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the billing practice of

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Mottishaw into the invention of Niedereder. One of ordinary skill in the art would have been motivated to do so in order to bill a customer based on the quality and usage of a service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 21, 2008



**NAEEM HAQ
PRIMARY EXAMINER**